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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/236,339    01/25/99    KASHIWABA    S    865.4327

005514    MM22/0303  
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NEW YORK NY 10112

EXAMINER

NGUYEN, T

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 03/03/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/236,339

Applicant(s)  
Kashiwaba et al

Examiner  
Thong Q. Nguyen

Group Art Unit  
2872



☒ Responsive to Election communication(s) filed on Dec 15, 1999

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) 12-18 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of the invention I, including claims 1-11, in Paper No. 9 of 12/15/1999 is acknowledged. The traversal is on the ground(s) that "a thorough search of the relevant art for Group I will require substantially consideration of the art relevant to Group II. Separate search and examination by separate Examiners may lead to duplicate work and inconsistent results...in the present application." (Election, Paper No. 9, page 2 (last seven lines) through page 3 (first two lines). This is not found persuasive because of the following reasons.

First, The Examiner respectfully disagrees to applicant's opinion that the search for the invention I and the search for the invention II will overlap to each other. The reasons of this conclusion are based on the features recited in the present claims 1-18 in which the features of one invention are not claimed/recited in the other invention. For instance, the invention II is directed to an image-shake correcting device mounted on an optical apparatus wherein the device comprises at least one lens (group) being decentered with respect to an optical axis via the operation of a driving system for the purpose of compensating image blurs. The features concerning the movement of lens (group) in a direction perpendicular to an optical axis and the driving mechanism used to decenter the lens (group) as recited in the invention II, claims 12-18, have not recited in the invention I, claims 1-11. It is noted that the support of the Examiner's opinion is also based on the teachings provided in the present specification. In the specification, in the first embodiment as described at pages 14-30 and shown in figs. 3-4, the movement of the

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third lens group (L3) and the sixth lens group (L6) are the movement along an optical axis and the optical holding mechanism is used for coupling the third and sixth lens groups. The movement of a lens (group) in a direction perpendicular to the optical axis and the driving system for making the movement of such lens (group) is directed to the second embodiment (see specification at page 30+ and figures 5+) in which the fifth lens (group) (L5) is used, not the third and the sixth lens groups of the first embodiment.

Second, the search of the invention I is in class 359, subclasses 694-706, and the search of the invention II is in class 359, subclasses 554-557. The search of the invention I does not need to cover the subclasses which are searched for the invention II and vice versa (see also the previous office action in which the field of searches of the inventions were clearly provided by the Examiner). As a result, the searches of both inventions I and II are a serious burden on the Examiner part.

Third, applicant's reason that the duplicate work and inconsistent results caused by separate search and examination of different examiners is not a proper reason for argument a restriction requirement. In order for the applicant to present a cogent argument relative to the restriction requirement, applicant must demonstrate that the Examiner's restriction requirement is in error or applicant must show that the two inventions are not patentable with respect to each other by showing a written evidence.

The requirement is still deemed proper and is therefore made FINAL.

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**As a result of applicant's election, the invention I which includes claims 1-11 are examined in this Office action, and the invention II which includes claims 12-18 has been withdrawn from further consideration and being directed to non-elected invention.**

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

The corrected or substitute drawings were received on 01/25/1999. These drawings are approved by the Office draftsman and the Examiner.

***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by the prior art as described at pages 2-5 and shown in fig. 1 of the present application.

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The prior art as described at pages 2-5 and shown in fig. 1 of the present application discloses an optical apparatus having an apparatus body and an optical-element holding mechanism. The optical-element holding mechanism as described comprises a first lens tube (3) for holding a first lens group (5), a second lens tube (6) for holding a second lens group (7), a coupling system (8a,8c) for coupling the first and two lens tubes, and an urging member (8b) disposed between the urging spring (8c) of the coupling system and the second lens tube (6) to urge and press the second lens tube against the first lens tube.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as described at pages 2-5 and shown in fig. 1 of the present application in view of Tsai (U.S. Patent No. 5,700,103).

The prior art as described at pages 2-5 and shown in fig. 1 of the present application discloses an optical apparatus having an apparatus body and an optical-element holding mechanism. The optical apparatus as described comprises a first lens group (5), a second lens tube (6) and a coupling member (9) for coupling the second lens group (7) against the first lens group

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(5). It is noted that the coupling system for coupling the second lens group against the first lens group of the prior art does not have a washer disposed between the screw and the second lens tube for urging and pressing the second lens tube against the first lens tube, and a deformable restricting and friction preventive member for restricting and preventing friction force between the screw and the second lens tube. However, the use of a washer and a deformable plate with a screw for the purpose of coupling two elements together is known to one skilled in the art as can be seen in the coupling system provided by Tsai. See columns 2-3 and figs. 3-5. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the coupling system as provided in the prior art described in the present specification by using a coupling system having a screw, a washer and a supporting plate as suggested by Tsai for the purpose of preventing friction force to the second lens tube, preventing the deformation of the connecting portions between the first and second lens tubes while still providing a coupling process of the two lens tubes.

### *Conclusion*

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references are cited as of interest in that each discloses a coupling mechanism comprises at least one screw and a washer for coupling two elements together.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exam. Nguyen whose telephone number is (703) 308-4814. The fax phone

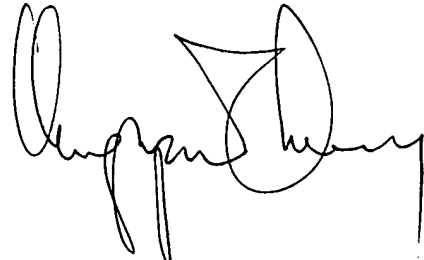
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number for the organization where this application or proceeding is assigned is (703) 308-7722 (or 7724).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Nguyen

02/25/00



Thong Nguyen  
Primary Examiner